

IN THE DRAWINGS

Enclosed herewith are two (2) sheets of corrected drawings bearing respective sheet number indications 1/2 and 2/2 and labeled to identify each such sheet as "Replacement Sheet" pursuant to 37 CFR §1.121(d). Each of the enclosed corrected drawing sheets is intended to be a one-for-one substitution for a corresponding (e.g., similarly numbered) one of the formal drawings previously submitted on April 7, 2005, and to which the current drawing rejection is addressed. Prompt entry of the enclosed corrected drawing sheets is respectfully requested.

REMARKS

The present Response is intended to be fully responsive to the objections and rejections raised in the Office Action, and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any portion of the Office Action not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

As of the mailing of the present Office Action, claims 1-29 were pending in the application. In the Office Action, the Examiner noted that:

1) the prior art cited in the Information Disclosure Statement filed on November 10, 2003 has been considered;

2) all certified copies of the priority documents have been received, and acknowledgement is made of a corresponding claim for foreign priority under 35 U.S.C. §119(a)-(d) or (f);

3) the formal drawings filed on April 7, 2005 are objected to;

4) the specification is objected to;

5) claim 2 is objected to on the basis of an alleged informality;

6) claim 29 is rejected under 35 U.S.C. §101 on the basis of the claimed invention being directed to non-statutory subject matter;

7) each of claims 3, 5, 8, 13, and 24 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention;

8) each of claims 2 and 3 is rejected as being allegedly obvious under 35 U.S.C. §103(a) over U.S. Patent No. 7,046,396 to Chan (*Chan*) in view of U.S. Patent No. 6,563,510 to Rice *et al.* (*Rice*); and

9) each of claims 1 and 4-29 is rejected under 35 U.S.C. §102(e) as being anticipated by *Chan*.

By this response, corrected drawings bearing respective sheet number indications 1/2 and 2/2 are submitted in substitution for the formal drawings previously submitted on April 7, 2005, portions of the Specification (including the SUMMARY OF THE INVENTION, DETAILED DESCRIPTION OF THE INVENTION, and ABSTRACT sections thereof) are amended, each of claims 2, 3 and 12 is canceled without

prejudice, each of claims 1, 4, 5, 6, 7, 8, 9, 10, 11, 13, 14, 15, 16, 17, 18, 19, 20, 24, 25, 26, 28, and 29 is amended, and new claims 30-36 are added. Upon the entry of the above Amendment to the Claims, the pending claims of the application will be Claims 1, 4-11, and 13-36. Of the pending claims in the application, each of Claims 1, 18, and 29 is presented in independent form. In view of the above amendments and the following discussion, the Applicants submit that the Examiner's concerns underlying the above-mentioned objections to the drawings, the specification, and claim 2 have been fully addressed, and that each of the claims presently pending in the application is novel under 35 U.S.C. §102 and non-obvious under 35 U.S.C. §103, and is thus in condition for allowance. The Applicants respectfully request that the Examiner reconsider and withdraw all such objections and rejections, and issue a prompt notice of allowance with respect to all pending claims.

I. CONSIDERATION OF APPLICANT-CITED PRIOR ART

The Examiner has indicated that the prior art cited by the Applicants in the information disclosure statement filed 11/10/2003 has been considered. The Applicants appreciate and thank the Examiner for this indication of consideration.

II. PRIORITY UNDER 35 U.S.C. §119

The Examiner has indicated that all certified copies of the priority documents have been received, and that acknowledgement is made of a corresponding claim of foreign priority under 35 U.S.C. §119(a)-(d) or (f). The Applicants further appreciate and thank the Examiner for this document receipt indication, and for acknowledging the corresponding foreign priority claim.

III. SUBMISSION OF NEW CORRECTED DRAWING SHEETS

In the Office action, the Examiner objected to the formal drawings submitted on April 7, 2005 as failing to comply with 37 CFR 1.84(p)(5), stating that:

[the drawings] include the following reference character(s) not mentioned in the description: Fig. 1 reference characters (1,2,4,5,6,7,10), and Fig. 2 reference characters (1 through 10).
Corrected drawing sheets in compliance with 37 CFR § 1.121(d), or

amendment to the specification to add the reference characters(s) in the description in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figures is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

As indicated hereinabove, enclosed herewith for entry into the present application are two (2) sheets of corrected drawings bearing respective sheet number indications 1/2 and 2/2 and including respective labels to identify each such sheet as a "Replacement Sheet" pursuant to 37 CFR §1.121(d), and with respect to which, each of the Figure 1 reference characters 1, 2, 4, 5, 6, 7, 10, and each of the Figure 2 reference characters 1 through 10, collectively giving rise to the present drawing objection, has been respectively deleted. Each of the enclosed corrected drawing sheets is intended to be a one-for-one substitution for a corresponding (e.g., similarly numbered) one of the formal drawings previously submitted on April 7, 2005. In such circumstances, the Applicants submit that the Examiner's concerns with respect to each of FIGS. 1 and 2 including reference characters not mentioned in the description have been addressed. Withdrawal of the objection is therefore respectfully requested.

IV. OBJECTIONS TO THE SPECIFICATION

The Examiner objected to lines 7 and 12 of the Abstract, page 3 line 26 of the Summary section, and pages 13 (lines 4, 29 and 31) and 14 (lines 6, 9, and 23) of the Detailed Description of the Preferred Embodiments section for alleged informalities arising from perceived typographical errors and the use of various acronyms. In response, the Applicants respectfully direct the Examiner's attention to the above Amendments to the Specification and Abstract, by which various changes to the Specification and Abstract are implemented corresponding to the objections lodged by the Examiner, and to other general comments made by the Examiner with respect to the permissible use of trademarks in patent applications. In such circumstances, the

Applicants submit that the Examiner's concerns giving rise to the present objection have been addressed. In turn, withdrawal of the objections to the Specification is respectfully requested.

V. AMENDMENTS TO THE PENDING CLAIMS

The Applicants have amended independent claim 1 to more precisely define the presently claimed subject matter. For example, claim 1, directed to a method for generating a digital color standard system for the generation or reproduction of standardized colors, has been amended, *inter alia*, to 1) replace the term "spectrum" with the term "gamut", and 2) add a step of "representing the digitized discrete spectral color values by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut". No new matter has been added. Support for such amendment to claim 1 is found in the application, as filed (see, *e.g.*, as-filed claims 2, 3 and 12, and lines 8-19 of page 3 of the Specification (Summary of the Invention)).

The Applicants have amended independent claim 18 to more precisely define the presently claimed subject matter. For example, claim 18, directed to a computer system for generating a digital color standard system for the generation or reproduction of standardized colors, has been amended, *inter alia*, to 1) replace the term "spectrum" with the term "gamut", and 2) specify wherein the digitized discrete spectral color values are "representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete spectral color values are substantially equidistant to each other with respect to the color gamut". No new matter has been added. Support for such amendment to claim 18 is found in the application, as filed (see, *e.g.*, as-filed claims 2, 3 and 12, and lines 8-19 of page 3 of the Specification (Summary of the Invention)).

The Applicants have amended independent claim 29 to more precisely define the presently claimed subject matter. For example, claim 29, directed to a data carrier system, has been amended, *inter alia*, to 1) replace the term "device" with the term "computer readable medium configured for the storage of data thereon", 2) specify

wherein the digitized discrete spectral color values are "representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete spectral color values are substantially equidistant to each other with respect to the color gamut". No new matter has been added. Support for such amendment to claim 29 is found in the application, as filed (see, e.g., as-filed claims 2, 3 and 12, lines 8-19 of page 3 of the Specification (Summary of the Invention), and lines 1-5 of page 6 of the Specification (Summary of the Invention)).

The Applicants have amended claim 16 to more precisely define the presently claimed subject matter. For example, claim 16, directed to the method according to claim 1, has been amended, *inter alia*, to add a step of "processing the digitized discrete spectral color values". Support for such amendment to claim 16 is found in the application, as filed (see, e.g., as-filed claim 1).

VI. OBJECTION TO CLAIM 2

The Examiner objected to claim 2 because of an alleged informality. In response, the Applicants respectfully direct the Examiner's attention to the above Amendments to the Claims, by which claim 2 has been canceled without prejudice, such that the present objection to claim 2 has been rendered moot. Withdrawal of the objection to claim 2 is therefore respectfully requested.

VII. REJECTION OF CLAIM 29 UNDER 35 U.S.C. §101

The Examiner rejected claim 29 under 35 U.S.C. §101, stating:

[T]he claimed invention is directed to non-statutory subject matter (i.e., a "data carrier" which is specified as "a CD-ROM, a DVD-carrier, a set of digital data signals, a computer server of the like; specification, page 6, lines 1-2).

...

While the signal defined by claim 29 is man-made and tangible, it is NON-STATUTORY because the underlying process recites purely non-functional descriptive material, which is non-statutory per se.

[Citation to MPEP 2106.IV.B.1(a)(Nonfunctional Descriptive Material) omitted]

[Citation to MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) omitted]

Claim 29 currently recites "A data carrier comprising a device that is adapted to receive color data...". There is no functional relationship imparted by this data to a machine or computing device. Therefore, the claim is drawn to a non-functional descriptive material which is non-statutory per se, regardless of the medium carrying the signal.

Furthermore, when the data carrier is a set of digital data signals, the signal is NOT modulated via a carrier waver [sic], or encoded in a manner to facilitate its readability, thus NOT facilitating the functionality of the underlying process.

[Citation to MPEP 2106.IV.B.1(a)(Functional Descriptive Material) omitted]

The claimed signal imparts *color* data that constitute non-functional descriptive material. If the claimed signal were to constitute functional descriptive material, in a computer product claim, functional descriptive material requires a computer readable medium to "permit the data structure's functionality to be realized" (MPEP 2106.IV.B.1(a) ...). In the same manner, a signal must be modulated via a carrier wave or encoded in a manner that permits the data structure's functionality to be realized. The instant claim does not recite any form of modulation or encoding that would facilitate functionality, and is therefore non-statutory.

The rejection is respectfully traversed.

Claim 29 (as amended herein) recites "A data carrier system, comprising: a computer readable medium configured for the storage of color data thereon, and on which computer readable medium is stored color data, the color data being one selected from the group consisting of color recording characteristics data for recording substrates, color reproduction characteristics data for color materials, color appearance characteristics data for color reproducing processes, and combinations thereof, wherein the color data is generated by: a) providing a color gamut, b) dividing the color gamut into a plurality of discrete spectral color values, and c) digitizing the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over

at least a part of the color gamut, the digitized discrete spectral color values are equidistant to each other with respect to the color gamut."

The Examiner's rejection of claim 29 appears to stem from the Examiner's interpretation of the unamended language of such claim to include "a set of digital data signals", as such phrase is set forth on page 6, lines 1-2 of the Application. However, as the recitation of claim 29 (as amended herein) provided immediately above clearly shows, the amended claim is directed not to propagated signals, but to a data carrier system that includes, *inter alia*, computer readable media. In such circumstances, the Applicants submit that the Examiner's concerns giving rise to the present rejection of claim 29 under 35 U.S.C. §101 have been addressed. The Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection.

VIII. REJECTION OF CLAIMS 3, 5, 8, 13, AND 24 UNDER 35 U.S.C. §112

The Examiner rejected claim 3 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. More particularly, the Examiner stated that there is insufficient antecedent basis for the limitation "the color gamut" in line 2 of claim 3. In response, the Applicants direct the Examiner's attention to the above Amendment to the Claims, by which claim 3 has been canceled without prejudice, such that the present rejection of claim 3 under 35 U.S.C. §112 has been rendered moot. Withdrawal of the rejection of claim 3 is therefore respectfully requested.

The Examiner rejected claims 5, 8 and 24 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. More particularly, the Examiner stated that the phrases "alternative printing device" (claim 5) and "alternative printing component" (claims 8 and 24) refer to items which are indefinite and do not clearly set forth the metes and bounds of the claimed invention. In response, the Applicants direct the Examiner's attention to the above Amendment to the Claims, by which each of claims 5, 8 and 24 has been amended to delete the phrases in question, such that the present rejections of such claim under 35 U.S.C. §112 have

been rendered moot. Withdrawal of the rejections of claims 5, 8 and 24 is therefore respectfully requested.

The Examiner rejected claim 13 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. More particularly, the Examiner stated that there is insufficient antecedent basis for the limitation "the recording substrate" in line 1 of claim 13. In response, the Applicants direct the Examiner's attention to the above Amendment to the Claims, by which claim 13 has been amended to read as follows: "The method according to claim 1, wherein a recording substrate is spectrally measured to provide a recording substrate-specific spectral color data set, and at least one of the discrete spectral color values and the digitized discrete spectral color values is adjusted according to said recording substrate-specific spectral color data set." Since the term "recording substrate" is now positively recited in claim 13, no antecedent basis for such term need be set forth in claim 1. In such circumstances, the Applicants submit that the present rejection of claim 13 under 35 U.S.C. §112 has been rendered moot. The Applicants therefore respectfully request that the rejection of claim 13 be reconsidered and withdrawn.

IX. REJECTION OF CLAIMS 1 and 4-29 UNDER 35 U.S.C. §102(e)

The Examiner rejected claims 1 and 4-29 (as filed) as being allegedly anticipated under 35 U.S.C. §102(e) by *Chan*. More particularly, with respect to independent claims 1, 18, and 29, the Examiner stated:

As for claim 1, CHAN teaches a method for generating a digital color standard system for the generation or reproduction of standardized colors [CHAN provides a system "for identifying a desired ink color and a formulation for a matching ink color"; col. 1, lines 56-58], comprising

- a. Dividing a color spectrum into a plurality of discrete spectral color values with predetermined gaps between at least some of the discrete spectral color values;** [This limitation corresponds to a database of discrete spectral color values. CHAN teaches that a spectrophotometer 14, color monitor 16, and viewing booth 18 are used ... to create a color data base associated with a set of ink base colors"; col. 3, lines 43-46, and cites, "The database is prepared by measuring", with the spectrophotometer, "the color information for print samples

prepared from the ink color base set and/or from combinations thereof at [different] concentrations or strengths. The database contains a sufficient number of color information points so that the computer can extrapolate, if necessary, the color information that would result from the different combinations of the ink base color set"; col. 5, lines 38-45]

b. Digitizing the discrete spectral color values; [Computer databases store information as digitized, discrete values. As noted previously, CHAN teaches the use of a spectrophotometer to measure "print samples prepared from the ink color base set" which are then stored in a database] and

c. Processing the digitized color values ["Processing" of the digitized color values may include the transmission of such color values from the "second computer" to the "first computer", including the display of such values on a monitor. "The second computer 10 (illustrated as the servers) selects an ink formulation and transmits the color data associated with the selected formulation to the first computer 4"; col. 3, lines 31-33. Furthermore, a software package "converts the spectral data of a color that is input from the computer 4 or the database software 22 to the digital information that will produce the same color on the screens of monitor 6 and 16"; col. 3, lines 52-55].

...

As for claim 18, CHAN teaches a computer system for generating a digital color standard system for the generation or reproduction of standardized colors [CHAN provides a system "for identifying a desired ink color and a formulation for a matching ink color"; col. 1, lines 56-58]; comprising a processor [FIG. 1 "server" (or "second computer") 10] that is programmed to:

(i) divide a color spectrum into a plurality of discrete spectral color values with predetermined gaps between at least some of the discrete spectral color values; [This limitation corresponds to a database of discrete spectral color values. CHAN teaches that a spectrophotometer 14, color monitor 16, and viewing booth 18 are used ... to create a color data base associated with a set of ink base colors"; col. 3, lines 43-46, and cites, "The database is prepared by measuring", with the spectrophotometer, "the color information for print samples prepared from the ink color base set and/or from combinations thereof at [different] concentrations or strengths. The database contains a sufficient number of color information points so that the computer can extrapolate, if necessary, the color information

that would result from the different combinations of the ink base color set"; col. 5, lines 38-45]

(ii) **digitize the discrete spectral color values**; [Computer databases store information as digitized, discrete values. As noted previously, CHAN teaches the use of a spectrophotometer to measure "print samples prepared from the ink color base set" which are then stored in a database] and

(iii) **process the digitized color values** ["Processing" of the digitized color values may include the transmission of such color values from the "second computer" to the "first computer", including the display of such values on a monitor. "The second computer 10 (illustrated as the servers) selects an ink formulation and transmits the color data associated with the selected formulation to the first computer 4"; col. 3, lines 31-33. Furthermore, a software package "converts the spectral data of a color that is input from the computer 4 or the database software 22 to the digital information that will produce the same color on the screens of monitor 6 and 16"; col. 3, lines 52-55].

...

As for claim 29, CHAN teaches a *data carrier* comprising

A device [FIG. 1 "second computer" or server 10]

that is adapted to receive color data [A "remote location includes a spectrophotometer 2, a first computer (central processing unit) 4, a color monitor 6 electronically connected to the computer, and a viewing booth 8. The spectral data of a color sample of the desired color is obtained using the spectrophotometer 2. The color data for the desired color is input into the computer 4, which transmits the data to a second computer 10"; col. 2, lines 52-59. "The second computer 10 (illustrated as the server) selects an ink formulation and transmits the color data associated with the selected formulation to the first computer 4"; col. 3, lines 31-33.

CHAN further teaches that the "second computer" may also consider "color recording characteristics" for the type of "recording substrate", "color reproduction characteristics" for the type of "color material", and the "color appearance characteristics" for the "color reproducing process". That is, the color data that is stored on the "second computer" and is transmitted to the "first computer" is data which takes into account these various characteristics. CHAN cites, "it is especially preferred to include additional information relating to the print

substrate, printing equipment, and other information that may affect the color match on the substrate or performance of the ink. Examples of such information include, without limitation, type of substrate, color of substrate, print process (e.g., offset, gravure, sheetfed, flexographic, etc.), type of printing equipment, press speed, and/or type of ink or ink properties desired"; col. 4, lines 30-37. Therefore, the following additional limitations are anticipated by CHAN.

that is selected from the group consisting of color recording characteristics data for recording substrates [i.e., "type of substrate, color of substrate"],

color reproduction characteristics data for color materials [i.e., "type of ink or ink properties desired"],

color appearance characteristics data for various color reproducing processes [i.e., type of "print process", "printing equipment"], and combinations thereof,

wherein said color data is generated by:

(i) dividing a color spectrum into a plurality of discrete spectral color values with predetermined gaps between at least some of the discrete spectral color values; [This limitation corresponds to a database of discrete spectral color values. CHAN teaches that a spectrophotometer 14, color monitor 16, and viewing booth 18 are used ... to create a color data base associated with a set of ink base colors"; col. 3, lines 43-46, and cites, "The database is prepared by measuring", with the spectrophotometer, "the color information for print samples prepared from the ink color base set and/or from combinations thereof at [different] concentrations or strengths. The database contains a sufficient number of color information points so that the computer can extrapolate, if necessary, the color information that would result from the different combinations of the ink base color set"; col. 5, lines 38-45]

(ii) digitizing the discrete spectral color values; [Computer databases store information as digitized, discrete values. As noted previously, CHAN teaches the use of a spectrophotometer to measure "print samples prepared from the ink color base set" which are then stored in a database] and

(iii) processing the digitized color values ["Processing" of the digitized color values may include the transmission of such color values from the "second computer" to the "first computer", including the display of such values on a monitor. "The second

computer 10 (illustrated as the servers) selects an ink formulation and transmits the color data associated with the selected formulation to the first computer 4"; col. 3, lines 31-33. Furthermore, a software package "converts the spectral data of a color that is input from the computer 4 or the database software 22 to the digital information that will produce the same color on the screens of monitor 6 and 16"; col. 3, lines 52-55].

The rejection is respectfully traversed.

Chan generally teaches a system that includes a first computer that can communicate with a second computer, wherein the second computer sends information to the first computer that includes a desired ink color and optionally includes information of other desired ink properties, and the first computer includes a database of data for predicting color data of ink formulations using a selected ink base color set, a software program for selecting an ink formulation based on data for a desired ink, and a software program for sending information to the second computer to display the color of the selected ink formulation on a color monitor connected to the second computer. (*Chan*, Abstract.) More particularly, *Chan* teaches wherein a spectrophotometer 14, a color monitor 16, and a viewing booth 18 are used to create a color database associated with a set of ink colors for manufacturing the ink. (*Chan*, col. 3, lines 43-47.) The database is created by measuring the color information for print samples prepared from the ink color base set and/or combinations thereof at different concentrations or strengths, wherein the database contains a sufficient number of color information points so that the computer can extrapolate, if necessary, the color information that would result from the different combinations of the ink base color set (in other words, the computer calculates a synthesized spectral curve or other color information for the ink formulation based on the color information for the different concentrations of each ink base color). (*Chan*, col. 5, lines 38-48.)

Chan, however, does not teach each and every element of the Applicants' invention recited in any of the presently pending claims. For example, independent claim 1 (as amended herein) recites a method including, *inter alia*, dividing a color gamut into a plurality of discrete spectral color values, digitizing the discrete spectral color values, and representing the digitized discrete spectral color values by means of at least one reflectance curve specified in regular intervals and wherein over at least a

part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut. For another example, independent claim 18 (as amended herein) recites a computer system comprising, *inter alia*, a processor programmed to divide a color gamut into a plurality of discrete spectral color values, and to digitize the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut. For yet another example, independent claim 29 (as amended herein) recites a data carrier system comprising, *inter alia*, a computer readable medium configured for the storage of color data thereon, and on which computer readable medium is stored color data, the color data being generated by providing a color gamut, dividing the color gamut into a plurality of discrete spectral color values, and digitizing the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut.

Chan, by contrast, fails to teach or suggest any manner of method or apparatus for dividing a color gamut into a plurality of discrete spectral color values, and digitizing the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut. For example, to the extent *Chan* discloses measuring the color information for print samples prepared from an ink color base set at different concentrations or strengths, *Chan* fails to teach or suggest a color spectral curve representing the resultant color information points, and in which the color information points are equidistant to each other with respect to a color gamut. As indicated by the following quote taken from the present Office Action, the Examiner has already conceded the above-described shortcomings of *Chan*: "CHAN does not specifically teach the method

according to claim 1, wherein at least one of the discrete spectral color values is equidistant at least over a part of the color spectrum.”

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). Since *Chan* does not teach any manner of method or apparatus for dividing a color gamut into a plurality of discrete spectral color values, and digitizing the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut, *Chan* does not teach each and every element of the Applicants’ invention recited in any of claims 1, 18, or 29. Accordingly, the Applicants contend that each of claims 1, 18 and 29 is patentable over *Chan*, and, as such, fully satisfies the requirements of 35 U.S.C. §102.

Each of claims 4-11, 13-17, and 19-28 depends, either directly or indirectly, from one or the other of claims 1 and 18, and recites additional features therefor. *Chan* does not anticipate the Applicants’ invention recited in either of claims 1 or 18. In such circumstances, *Chan* also fails to anticipate the Applicants’ invention recited in any of claims 4-11, 13-17, and 19-28. Accordingly, the Applicants contend that each of claims 4-11, 13-17, and 19-28 is patentable over *Chan*, and, as such, fully satisfies the requirements of 35 U.S.C. §102. The Applicants respectfully request withdrawal of the present rejection.

X. REJECTION OF CLAIMS 2 and 3 UNDER 35 U.S.C. §103(a)

The Examiner rejected each of claims 2 and 3 as being allegedly obvious under 35 U.S.C. §103(a) over *Chan* in view of *Rice*.

As a preliminary response to the present obviousness rejection, the Applicants would respectfully direct the Examiner’s attention to the above Amendment of the Claims, by which at least some of the collective subject matter recited in as-filed claims 2 and 3 has been incorporated into the independent claim from which each such claims

depended (*i.e.*, independent claim 1), as well as into each of independent claims 18 and 29. In such circumstances, the Applicants anticipate that the Examiner may elect to apply against each of independent claims 1, 18 and 29 substantially the same obviousness allegations set forth in the present rejection of as-filed claims 2 and 3. Accordingly, for the convenience of the Examiner, and in the spirit of providing a full and complete response to the present Office action, the Applicants will now provide arguments to show wherein none of independent claims 1, 18 and 29 (as amended herein) is obvious over the cited combination of *Chan* and *Rice*, such that each such claim is patentable over both such references.

In direct response to the present obviousness rejection of claims 2 and 3 over the cited combination of *Chan* and *Rice*, the Applicants respectfully direct the Examiner's attention to the above Amendments to the Claims, by which each of claims 2 and 3 has been canceled without prejudice. In such circumstances, the Applicants submit that the present obviousness rejection of claims 2 and 3 over *Chan* in view of *Rice* has been rendered moot. Accordingly, the Applicants respectfully request that the Examiner withdraw the present obviousness rejection.

Turning now to the presumed contention on the part of the Examiner that independent claim 1 (as amended) would be obvious over the cited combination of *Chan* and *Rice*, such a rejection is respectfully (preliminarily) traversed.

As the Examiner is aware, to establish a *prima facie* case of obviousness, one of the basic criteria that must be met is that the prior art reference (or references when combined) must teach or suggest all the claimed limitations. *In re Vaeck*, 947 F. 2d, 488 (Fed. Cir. 1991). Here, a *prima facie* case of obviousness has not been established, at least because independent claim 1 recites a method that includes limitations not taught nor suggested in either of *Chan* or *Rice*, whether taken alone or in combination.

As has been demonstrated above, *Chan* fails to teach or suggest a color spectral curve representing the resultant color information points, and in which the color information points are equidistant to each other with respect to a color gamut. The Examiner appears to recognize *Chan*'s shortcomings in this regard, as evidenced by the following statements from the present Office action:

...CHAN does not specifically teach the method according to claim 1, wherein the discrete spectral color values are equidistant [from] each other with respect to ... a color gamut.

Being of the position that *Rice* supplies that which has been revealed to be absent in *Chan*, the Examiner further offers the following observations regarding the teachings of *Rice*:

RICE teaches a paint color matching system, wherein the "paint color samples have been arranged according to the guiding principle that adjacent samples should represent equal intervals of visual color perception", col. 8, lines 36-38.

and concludes, at least in part on that basis, that the respective subject matter of each of as-filed claims 2 and 3 is obvious.

Rice generally teaches a paint color matching and coordinating system comprising an interface for receiving an input reference color, a processor capable of reading a memory, a memory including (1) instructions readable by the processor and (2) a database of architectural paint colors spanning all or most of the known color space, wherein color space is divided into a plurality of fixed, generally equally sized, non-overlapping, contiguous portions, each color space portion being defined as the space of all colors within a band of hues within color space, and (3) a display generator. (*Rice*, Abstract.) In use, the interface of the system receives an input reference color from a user, and the processor selects from the database a "reference paint color" that is visually closer to the input reference color than any other paint color in the database. (*Id.*) The processor selects five sets of paint colors, one set from each of the color space portions that include the five hues that comprise what is termed in *Rice* a "five-way harmony" of the reference paint color, and may also select a sixth set of paint colors from the color space portion that includes the particular hue of the reference paint color. (*Id.*) The processor further directs the display generator to create a display of color samples of the reference paint color and the first through sixth sets of paint colors. (*Id.*)

A further study of *Rice*, however, reveals that the reference fails to supply the above-indicated subject matter set forth in all of the pending claims that is absent from *Chan*. More particularly *Rice*, whether considered singly or in combination with *Chan*,

fails to teach any modification or enhancement to the teachings of *Chan* to provide, for example, a color spectral curve representing the resultant color information points of *Chan*, and in which the color information points are equidistant to each other with respect to a color gamut. More particularly, *Rice*, dwelling as it does on the conventional practice of providing equal intervals of visual color perception fails to recognize the differences between such a regime and the presently claimed regime (e.g., wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut). Still further, to the extent *Rice* teaches dividing color space into a plurality of equally sized contiguous portions, *Rice* does so based not on differences between colors, but rather, on variations in hue, such that each and every color of the color space would presumably be represented in each and every contiguous color space portion. (*Rice*, Abstract.)

In any event, the Applicants submit that those of ordinary skill in the art, upon being presented with the teachings set forth in the present application, would readily recognize the presently claimed regime, which provides that the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut, as being distinct and different, both from a functional and a conceptual standpoint, from the conventional regime of providing equal intervals of visual color perception in accordance with the teachings of *Rice*. The following passage from page 3, lines 8-19, provide further illumination demonstrating not only the non-obviousness of the present regime, but also many of the advantages to be obtained thereby:

[I]t is advantageous to provide discrete spectral color values which are equidistant to each other with respect to the color gamut, since the color gamut defines an area in the color space which contains all the colors which may be reproduced using the primary sources. The reference white is the center of the color gamut area, and colors lying close to the reference white are the less saturated colors. Colors located far from this point are the more saturated colors. If this color gamut is divided into a network of equidistant discrete spectral color values or gamut values and these values are digitized, it is possible to provide a digital color swatch book of all the available colors within a color gamut. If a standard color gamut is defined, it is possible to define a digital standard swatch book for this standard color gamut. It

is also possible to develop a plurality of digital color swatch books on the basis of different closed loops through the saturated color gamut, providing different colors with the same saturation.

In such circumstances, *Rice* would appear to fail, *inter alia*, to teach or suggest a modification to the teachings of *Chan* that would yield an apparatus for, or a method including, dividing a color gamut into a plurality of discrete spectral color values, and digitizing the discrete spectral color values, wherein the digitized discrete spectral color values are representable by means of at least one reflectance curve specified in regular intervals and wherein over at least a part of the color gamut, the digitized discrete color spectral values are substantially equidistant to each other with respect to the color gamut, as required by each of independent claims 1, 18 and 29. As such, a *prima facie* case of obviousness has not been established because the combination of the cited references fails to yield a method that includes all of the limitations recited in any of independent claims 1, 18 or 29. Thus, the Applicants respectfully submit that each of independent claims 1, 18 and 29 is patentable over *Chan* in view of *Rice*, and on that basis at least, should be allowed.

Claims 4-11, 12-17, and 19-28 depend, either directly or indirectly, from one or the other of independent claims 1 and 18, and recite additional features therefor. At least since the subject matter of each of independent claims 1 and 18 is not obvious in view of the cited combination of *Chan* and *Rice*, the subject matter of each of claims 4-11, 12-17, and 19-28 is similarly not obvious in view thereof. Accordingly, the Applicants respectfully submit that each of claims 4-11, 12-17, and 19-28 is patentable over all the art of record, including specifically the cited combination of *Chan* and *Rice*, and on that basis at least, should be allowed.

XI. NEW CLAIMS 30-36 ALLOWABLE

The Applicants respectfully direct the Examiner's attention to the above Amendment to the Claims, in which new claims 30-36 are set forth. No new matter has been added to the application. Support for new claims 30-36 is set forth in the application, as filed (see, e.g., as-filed claims 2, 3 and 12, lines 8-19 of page 3 of the Specification (Summary of the Invention), and lines 1-5 of page 6 of the Specification

(Summary of the Invention)). The Applicants respectfully submit that new claims 30-36 are allowable over the prior art currently of record for at least the same reasons set forth above to demonstrate the allowability of pending claims 1, 4-11, and 13-29.

CONCLUSION

In view of the foregoing, the Applicants submit that the Examiner's concerns leading to the present objections to the drawings and the claims of the application have been fully and completely addressed, and each of the claims presently pending in the application is directed to patentable subject matter and is patentable over all of the prior art currently of record. Accordingly, swift issuance of a notice of allowance with respect to all pending claims is earnestly solicited.

If, however, the Office believes that any unresolved issues still exist or if, in the opinion of the Office, a telephone conference would expedite passing the present application to issue, the Office is invited to call the undersigned attorney directly at 203-399-5920 or the office of the undersigned attorney at 203-399-5900 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,



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